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PRE-APPEAL BRIEF REQUEST FOR REVIEW

Docket Number (Optional)

059406.00017

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on _____

Signature _____

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Name _____

Application Number:

10/814,343

Filed: April 1, 2004

First Named Inventor:

Yoshiaki SAKAGAMI

Art Unit: 2624

Examiner: Elisa M. Rice

Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request.

This request is being filed with a Notice of Appeal.

The review is requested for the reason(s) stated on the attached sheet(s).

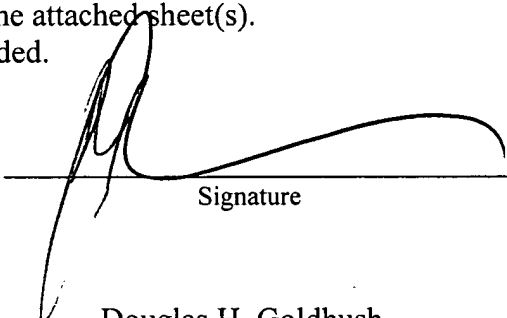
Note: No more than five (5) pages may be provided.

I am the

- ☐ Applicant/Inventor.
- ☐ assignee of record of the entire interest.
See 37 CFR 3.71. Statement under
37 CFR 3.73(b) is enclosed (Form PTO/SB/96)

☒ Attorney or agent of record.
Registration No. 33,125

☐ Attorney or agent acting under 37 CFR 1.34.
Registration Number if acting under 37 CFR 1.34 _____


SignatureDouglas H. Goldhush

Typed or printed name

703-720-7800

Telephone number

January 29, 2009

Date

NOTE: Signatures of all of the inventors or assignees of record of the entire interest or their representative(s) are required. Submit multiple forms if more than one signature is required, see below*.

☐ *Total of _____ forms are submitted.

This collection of information is required by 35 U.S.C. 132. The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.11, 1.14 and 41.6. This collection is estimated to take 12 minutes to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Mail Stop AF, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re the Application of:

Confirmation No.: 5345

Yoshiaki SAKAGAMI et al.

Art Unit: 2624

Application No.: 10/814,343

Examiner: Elisa M. Rice

Filed: April 1, 2004

Attorney Dkt. No.: 059406.00017

For: IMAGE TRANSMISSION SYSTEM FOR A MOBILE ROBOT

PRE-APPEAL BRIEF REQUEST FOR REVIEW

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

January 29, 2009

Sir:

In accordance with the Pre-Appeal Brief Conference Pilot Program guidelines set forth in the July 12, 2005 Official Gazette Notice, Applicants hereby appeal the rejections noted in the final Office Action dated October 30, 2008, and request Pre-Appeal Brief Request for Review of these rejections. As will be discussed below, numerous legal and factual errors have been made which require that the rejections be withdrawn.

Claim 1 was rejected under 35 USC § 103(a) as being unpatentable over Higaki (U.S. Patent Publication No. 2004/0028260 A1) in view of Kuno (U.S. Patent No. 5,802,494). Claims 2, 4, 5, 6, and 7 were similarly rejected under 35 USC § 103(a) as being unpatentable over Higaki in view of Kuno. Claim 3 was rejected under 35 USC § 103(a) as being unpatentable over the combination of Higaki and Kuno, and further in view of Shinichi (Japanese Patent Publication No. 2000-326274). Claim 4 was rejected under 35 USC § 103(a) as being unpatentable over Higaki and Kuno, and further in view of Ishii (U.S. Patent No. 6,278,904). Claim 8 was rejected under 35 USC § 103(a) as being unpatentable over Higaki and Kuno. Applicants respectfully traverse these rejections, and submit that Higaki is not a proper reference upon which to base rejections against these claims.

As explained in applicants' previous responses, and in the Declarations which have been filed under 37 CFR § 1.131, the subject matter of the present application corresponds to the

subject matter which is described in Japanese Patent Application No. 2003-094171, which was filed on March 31, 2003, in Japan. The applicants had the intent to file the U.S. patent application and claim priority rights under 35 USC § 119(a), as evidenced by an order letter to their Japanese attorneys, Oshima & Narushima, on January 8, 2004. Copies of all pertinent documents are already in the file.

On March 4, 2004, an order letter was sent from Oshima & Narushima to the law firm of Squire Sanders & Dempsey LLP, instructing Squire Sanders & Dempsey to prepare and file the application in the United States by March 31, 2004, claiming benefit of the Japanese priority filing date. However, this letter was contained in a package containing several filing orders which had been sent to Squire Sanders & Dempsey, and it was not until April 1, 2004, that this application was noticed among the several patent applications. In the normal course, the order letter was erroneously placed with another application that was in the package. The subject U.S. application was immediately filed on April 1, 2004. There was a clerical error that resulted in the application being filed one day late. A clerical error resulting in a one-day delay is not evidence of a lack of diligence.

Higaki was filed on August 7, 2003, and published on February 12, 2004. The filing of Japanese Patent Application No. 2003-094171 on March 31, 2003, clearly establishes conception of the invention prior to the effective date of Higaki. Diligence was exercised from prior to the effective date of Higaki until the filing date of the present application on April 1, 2004. A mistake in failing to identify the order letter in a stack of paper for a short period of time does not constitute evidence of a lack of diligence. Quite to the contrary, the filing of the application in Japan, the order letters from the applicant to their Japanese attorney, the order letter from the Japanese attorney to the U.S. attorney, and the actual filing of the application effectively show that applicants intended to claim the benefit of the earlier filing date under 35 USC § 119(a), and acted diligently to file the U.S. patent application.

In the final Office Action dated October 30, 2008, the position was taken by the Examiner that the Declaration filed on July 4, 2008, is ineffective to overcome Higaki because the applicant failed to show due diligence. The missing of the Paris Convention deadline by one day is not evidence of due diligence. This is evidence of a clerical error. However, applicants are not asserting a claim for priority in this declaration or in this appeal. Applicants submitted

these Declarations and the responses in an effort to show that applicants acted diligently to reduce the invention to practice through the filing of a United States patent application based upon Japanese Patent Application No. 2003-094171. The missing of the priority deadline by one day is not evidence of a lack of diligence. The attempt in the Office Action to connect the Paris Convention deadline to due diligence is a clear legal and factual error.

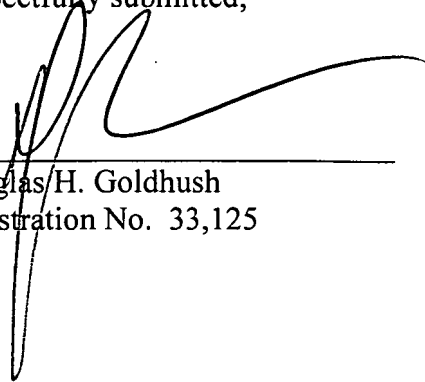
Under U.S. patent practice, a patentee must account for the entire critical period between the date of conception and the date of reduction to practice by showing either activity aimed at reduction to practice or legally adequate excuses for inactivity. The order letters to the Japanese and U.S. attorneys, and the filing date of April 1, 2004, is clearly evidence of due diligence. The commission of a clerical error does not "undo" all of the diligence which took place.

It is therefore respectfully submitted that the failure of the Examiner to withdraw the Higaki reference as being inapplicable to the present application is a clear legal error. Additionally, the Examiner appears to be confusing the Paris Convention deadline with the standards of diligence, and these are separate issues. The failure of the Examiner to accept March 31, 2003 as the invention date of the present invention is a clear error.

In view of these clear legal and factual errors, it is respectfully requested that all of the rejections of claims 1-8 based on Higaki be withdrawn, and this application passed to issue.

Reconsideration and withdrawal of the rejections, in view of the clear errors in the Office Action, is respectfully requested. In the event this paper is not being timely filed, the applicants respectfully petition for an appropriate extension of time. Any fees for such an extension together with any additional fees may be charged to Counsel's Deposit Account 50-2222.

Respectfully submitted,



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Enclosures: PTO/SB/33 Form
Notice of Appeal
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